



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/142,452	01/19/99	WACK	0 19866.PCT/FA

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EXAMINER

MARKOFF, A

ART UNIT	PAPER NUMBER
1746	6

DATE MAILED: 03/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/142,452

Applicant(s)

WACK ET AL.

Examiner

Alexander Markoff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 12-32 is/are rejected.
- 7) ☒ Claim(s) 4-11 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The Applicants filed a copy of the declaration pages 2 and 3 of which are in the conditions preventing recognition of what is in the Declaration. It is simply impossible to read pages 2 and 3 of the Declaration.

Moreover, it seems that the date of the execution of the Declaration is missing.

Claim Objections

2. Claims 4-11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim could not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-11 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 and 12-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1-3 and 12-32 are indefinite because the scope of the claims could not be understood. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document.

For example, claim 1 recite a process for cleaning articles but fails to recite any positive manipulating step. This is not proper for the current U.S. practice.

Further, even the claims, which recite manipulative steps (for example claim 12) are indefinite because it is not clear where the border of the preamble and the body of the claim. The Applicants are encouraged to use the clause "comprising the steps of:" to identify the required steps of the claimed method.

Moreover, the claims contain a lot of other problems such as using ", etc." in the recitation of the integers used in formulas (claims 20, 31), recitation of components in the way which could not be understood (claims 19, 23, 2), the use of improper Markush language, etc.

The Applicants are required to correct the claims and place them in the correspondence with current U.S. practice.

The claims would be examined to the extent of the best Examiner's understanding of the claimed subject matter.

It is noted that when the claims would be placed in the proper format and the scope of the claims would clearly determined a restriction requirement may be made if the claims would lack a common inventive concept.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1-3, 25 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by EPA 475,596.

EPA 475,596 teaches (entire document, especially columns 4 and 5) a method for cleaning articles by contacting them with a liquid mixture of water with an organic compound or with a vapor of the mixture of water and the organic compound to remove contaminants from the article. The vapor is allowed to condense on the article. The mixture forms an azeotrope during the "liquid phase-to-vapor phase transition.

As to claims 31 and 32:

The Applicants are trying to claims any organic compound having the general formula recited by claim 31. It is noted that numerous organic compounds would have this general formula. The Examiner can list just several examples: methanol, ethanol, isopropanol, terpenes, ethers, esters, etc.

Since EPA 475,596 recites the use of such compounds it meets all the claimed limitations.

7. Claims 12-32 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/28535.

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WO 96/28535 teaches a method for cleaning articles comprising contacting the article with an azeotropic cleaning composition comprising water and an organic compound, forming azeotrope of this composition and separating the phases of this composition. WO 96/28535 teach conducting the process at the claimed temperatures.

WO 96/28535 does not specifically state that the composition is an emulsion, however, since the cleaning is conducted at the same temperature at which the phase separation occurs it is inherent that the composition is an emulsion.

As to claims 31 and 32:

The Applicants are trying to claim any organic compound having the general formula recited by claim 31. It is noted that numerous organic compounds would have this general formula. The Examiner can list just several examples: methanol, ethanol, isopropanol, terpenes, ethers, esters, etc.

Since WO 96/28535 recites the use of such compounds it meets all the claimed limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday - Friday 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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305-7719 for regular communications and 703-305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read 'Alexander Markoff', with a stylized, flowing script.

Alexander Markoff
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am
February 27, 2000